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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,667	01/14/2004	Anthony John Kinney	BB1071 US DIV2	7292
23906 7590 10/15/2008 E I DU PONT DE NEMOURS AND COMPANY LEGAL PATENT RECORDS CENTER BARLEY MILL PLAZA 25/1122B 4417 LANCASTER PIKE WILMINGTON, DE 19805				
EXAMINER				
KUMAR, VINOD				
ART UNIT		PAPER NUMBER		
1638				
NOTIFICATION DATE		DELIVERY MODE		
10/15/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-Legal.PRC@usa.dupont.com

Office Action Summary

Application No.

10/757,667

Applicant(s)

KINNEY ET AL.

Examiner

Vinod Kumar

Art Unit

1638

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/24/04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of objections and rejections

1. Applicant's response filed in the paper of July 31, 2008 is entered.
2. Claims 22-24 are pending.
3. Claims 1-21 are previously canceled.
4. Claims 22-24 are examined on merits in the present Office action.
5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Rejections of claims 22-23 under 35 U.S.C. 112, 1st paragraph are withdrawn in light of claim amendments filed in the paper of July 31, 2008.

Claim Rejections - 35 USC § 102 & 103

7. Claims 22-24 remain rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Trueblood et al. (US Patent No. 4,267,118, issued on May 12, 1981) for the reasons of record stated in the Office action mailed on February 26, 2008. Applicant traverses the rejection in the paper filed on July 31, 2008.

Applicant argues that Trueblood et al. disclose a food grade soybean oil obtained by a process different from the process used to prepare the food of the instant invention. Applicant further argues that Trueblood et al. method resulted in food (oil) comprising less than 0.1% of protein, and in contrast soy protein products as instantly claimed was made from soy containing a high protein content. Applicant cites methods

of soybean processing used to obtain oil and seed meal to support their arguments (response, pg 9 through the end of 2nd paragraph of pg 10).

Applicant's arguments have been fully considered but are deemed to be unpersuasive.

It is maintained that the instantly claimed invention reads on soybean oil which inherently comprises oilbody proteins (e.g. oleosin, a soy protein) including other soy protein contaminants as admitted by Applicant in their response.

In response to applicant's argument that the reference fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., food which constitutes protein concentrates, isolates, and textured protein products derived from soybean seeds which is transformed with a suppression construct to down-regulate endogenous seed storage proteins) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 10

In response to applicant's argument that the reference fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., soy protein products as claimed is a product made from soy containing high protein content) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). 57 (Fed. Cir. 1993).

It is maintained that the instantly claimed food has the same structural limitations as that taught by the reference. Soybean oil as a food obtained from the claimed method appears to be identical to the soybean oil of the prior art which inherently comprises oleosins (same as soy protein). See *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) which teaches that "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process."

Accordingly, the rejection is maintained.

8. Claims 22-24 remain rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Staswick et al. (Archives of Biochemistry and Biophysics, 223:1-8, 1983) for the reasons of record stated in the Office action mailed on February 26, 2008. Applicant traverses the rejection in the paper filed on July 31, 2008.

Applicant argues that Staswick et al. disclose the analysis of the 11S storage protein (glycinin) in the soybean cultivar "Raiden". Applicant further argues that Staswick et al. suggest absence of certain acidic and basic polypeptides of the subunits that form the seed storage protein glycinin and the presence of a new acidic polypeptide which was called A6. Applicant further argues that the food of the instant invention is distinguishable from the food that could be prepared from the soybean cultivar

described by Statswick et al. by the presence or absence of chimeric gene (response, pg 10, 3rd paragraph through the end of 4th paragraph of pg 11).

Applicant's arguments have been fully considered but are deemed to be unpersuasive.

Applicant is reminded that the instantly claimed food comprising a soy protein product reads on soybean oil comprising soy proteins (e.g. oleosins) that are inherently present in soybean seeds. It is also maintained that Statswick et al. disclose soybean seeds having reduced levels of glycinin. The soybean seed storage proteins with reduced levels of glycinin would inherently constitute food. See in particular, page 1, abstract, introduction; page 2; left column.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., soy protein products as claimed contains chimeric construct) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).
57 (Fed. Cir. 1993).

It is maintained that the soybean seed storage proteins with reduced glycinin levels disclosed in the reference was not made using the same method as the instantly claimed food. However, the instantly claimed food has the same structural limitations as that taught by the reference. Soybean seed storage proteins with reduced glycinin levels as a food obtained from the claimed method appears to be identical to the

soybean seed storage proteins with reduced glycinin levels of the prior art. See *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) which teaches that "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process."

Conclusions

9. Claims 22-24 remain rejected.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinod Kumar whose telephone number is (571) 272-5444. The examiner can normally be reached on 8:30 am to 5:00 pm.

Art Unit: 1638

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on (571) 272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Phuong T. Bui/
Primary Examiner, Art Unit 1638